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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,182	12/31/2003	Kenichi K. Yabusaki	03-YAB-115	4353

23843 7590 08/17/2004

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EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,182

Applicant(s)

YABUSAKI, KENICHI K.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 15-18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/9/04, 7/15/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 1-13, 15-18, and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/26/2004.

2. Applicant's election with traverse of Species III in the reply filed on 7/26/2004 is acknowledged. The traversal is on the ground(s) that "The applicant does not believe that species I...is a distinct species from species II...applicant argues that claim 1 is a generic claim with respect to species II, III, IV, and V that, as amended, are written in dependent form from claim 1....". This is not found persuasive because the fact that species I and II have different respective features (cross-hatching vs. dimples) which have similar function is not the Examiner's reasoning behind the requirement for an election of species. Instead, each different feature which is unique to its respective species is not required in the search of the other species. If applicant is traversing on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Furthermore, applicant did not amend claim 1 such that it is generic to all of the species in the present application since claim 1 recites both "a finger sheath" (part nos. 82, 84, &

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86) and "a finger retainer, extending across the first end of the finger sheath..." (part no. 85 in Fig. 4) which is unique to Species IV, Fig. 4 and as disclosed at page 7, lines 26-30 of the specification. These recited limitations of claim 1 are not required in the other species which are disclosed as comprising a thimble and not a finger sheath.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19, 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 19, line 5, the phrase "of a type which" renders the claim vague and indefinite and should be deleted.

In regard to claim 19, lines 10-13, the phrase "a curved blade...a curvature matching a radius of curvature...at a position...the curved blade being attached to the thimble at the position" renders the claim vague and indefinite since the position at which the blade is attached should be recited before reciting where the curvature of the blade is located (basically reversing the phrases and locating the attachment point of the blade with the phrase "at a position on the first portion of the thimble which is near the second portion). Also see claim 22, lines 7-10 for the same problem.

In regard to claim 22, line 2, the term "acts" renders the claims vague and indefinite and should be changed to "steps".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19, 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cain 6,012,165.

Cain discloses a thimble (10) comprising an open end (at 16 or below 14) and a closed end (31) and a body (12, 14), the thimble including a first portion (12) extending from the closed end which **approximates a part of a right angle cone** and a second portion (14 OR lower part of 12 and also including 14) **which approximates a cylinder**; and a curved blade (26) having a curvature matching a radius of curvature of the thimble at a position on the first portion (see Fig. 4) and extending beyond the closed end (see Figs. 3, 4).

Allowable Subject Matter

7. Claims 22-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pietrandrea et al. 5,557,874 discloses means for opening a split shot (13, 13a) and closing a split shot (12a, b); Brown 2,603,992 discloses an instrument for closing and opening split sinkers on fishing lines comprising means for

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closing split sinkers (jaws 24, 26) and means for opening split sinkers (jaws 28, 30 made relatively thin and are bent to cause the thin edges to align when closed).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark
Primary Examiner
Art Unit 3643

DWA